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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,465	12/22/2000	Alexander V. Shmelev	77636.12523	1491

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EXAMINER

NORRIS, TREMAYNE M

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 06/25/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/720,465

Applicant(s)

SHMELEV, ALEXANDER V.

Examiner

Tremayne M. Norris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "12, 14, 16, 18, 20, 22, 24, 26". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 18,19,26,27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear to the examiner where it is taught within the specification that a pass phrase is included as a part of the executable program to "enable said predetermined site to download said suitable executable program" as stated in lines 2-3 in claim 18, and similarly in claim 26.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-39 rejected under 35 U.S.C. 102(e) as being anticipated by Mitty et al (US pat 6,199,052).

Regarding claim 1, Mitty teaches a method for the secure transmission of documents comprising the steps of:

using a security program at a sending location for creating an encrypted file including an executable program with the document;

transmitting said encrypted file to a remote recipient;

receiving said encrypted file at a location lacking said security program;

executing, at the receiving location, the received said executable program; and

decrypting said received file using said received program (col.2 lines 29-55).

Regarding claim 2, Mitty teaches including a pass phrase as a part of said executable program to prevent unauthorized decryption of the received said encrypted file (col.3 line 27 thru col.4 line 17).

Regarding claim 3, Mitty teaches including said pass phrase in the encryption algorithm used in the creation of said encrypted file (col.3 line 27 thru col.4 line 17).

Regarding claim 4, Mitty teaches said executable program includes, as a step when running, a verification step for confirming the integrity of the received file (col.6 lines 39-48).

Regarding claim 5, Mitty et al teach the step of creating includes a file compression step prior to the encryption of said file (col.7 lines 50-65).

Regarding claim 6, Mitty teaches a secure reply option comprising the steps of:  
providing, in said executable program, a option for a secure reply;  
electing, at said receiving end, the secure reply option;  
using said received executable program to create a secure reply file similar to that created by the security program at the transmitting end;  
transmitting said secure reply file from said remote location to said sending location; and

using said security program at said sending location to decrypt said secure reply file, whereby a receiving location lacking a security program can receive secure messages and send secure replies (col.8 lines 49-57; col.15 lines 15-67).

Regarding claim 7, Mitty teaches the steps of including a pass phrase in the creation of said secure file and wherein said received executable program requires said pass phrase for execution of said transmitted program (col.13 lines 50-58; col.17 line 40 thru col.18 line 7).

Regarding claim 8, Mitty teaches including the step of verifying the integrity of said secure reply file at said transmitting location (col.15 lines 60-62).

Claims 9-16 are substantially equivalent to claims 1-8 respectively, therefore claims 9-16 are rejected because of similar rationale.

Regarding claim 17, Mitty teaches a method for the secure transmission of documents comprising the steps of:

- using a security program at a sending location for creating an encrypted file including an executable program with the document;
- transmitting said encrypted file to a remote recipient;
- receiving said encrypted file at a location lacking said security program;

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executing, at the receiving location, the received said executable program (col.2 lines 29-55);

connecting to a predetermined site on a global computer network;

retrieving from said predetermined site a suitable executable program for decrypting said received encrypted file and

decrypting said received file using said retrieved program (col.13 line 60 thru col.14 line 5).

Regarding claim 18 (as best understood), Mitty teaches a pass phrase as a part of said executable program to enable said predetermined site to download said suitable executable program thereby preventing unauthorized decryption of the received said encrypted file (col. col.13 line 60 thru col.14 line 5).

Claims 19-24 are substantially equivalent to claims 3-8 respectively, therefore claims 19-24 are rejected because of similar rationale.

Claims 25-32 are substantially equivalent to claims 17-24 respectively, therefore claims 25-32 are rejected because of similar rationale.

Regarding claim 33, Mitty teaches a reply option comprising the steps of:

providing, in said suitable executable program, a option for a reply;

electing, at said receiving end, the reply option (col.15 lines 57-62);

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using said received suitable executable program to contact a second, predetermined global computer network site;

instructing said second global computer network site to take a selected action;

whereby a receiving location lacking a security program can receive secure messages and send instructions to a selected global computer network site (col.13 lines 45-58; col.14 lines 10-62).

Claim 34 is substantially equivalent to claim 7, therefore claim 34 is rejected because of similar rationale.

Regarding claim 35, Mitty teaches the step of sending a receipt confirmation to said sending location (col.14 lines 58-62).

Regarding claim 36, Mitty teaches the step of directing said selected second global computer network site to send a confirmation message to said sending location (col.14 lines 58-62).

Regarding claim 37, Mitty teaches including a means for creating a reply comprising:

communicating means in said suitable executable program for contacting a second predetermined global communication network site; and

means at said remote location for transmitting a predetermined instruction to said second global computer network site (col.13 lines 45-58; col.14 lines 10-62).



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Claims 38 and 39 are substantially equivalent to claims 35 and 36 respectively, therefore claims 38 and 39 are rejected because of similar rationale.

**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tremayne M. Norris whose telephone number is (703) 305-8045. The examiner can normally be reached on M-F 7:30AM-5:00PM alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703) 305-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tremayne Norris

May 17, 2004

  
MATTHEW SMITHERS  
PRIMARY EXAMINER  
Art Unit 2137